

REMARKS

Claims 1-4, 6-14, 16-41, and 43-70 remain in the application with claims 1 and 38 in independent form.

Judicially Created Obviousness-Type Double Patenting Rejection:

Claims 1-4, 6-14, 16-41, and 43-70 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 11-13, 19-22, 24-29, and 35 of United States Patent No. 6,789,905. Although the Applicant does not necessarily agree with the assertions made in paragraph 6 on page 4 of the Office Action, to expedite prosecution and allowance of the claims which stand rejected only under 'double patenting', specifically claims 36, 37, and 70, the Applicant submits herewith a timely filed Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c). The Terminal Disclaimer is accompanied by the fee required under 37 C.F.R. §1.20(d). Thus, the non-statutory obviousness-type double patenting rejection of claims 1-4, 6-14, 16-41, and 43-70 is overcome and claims 36, 37, and 70 are in condition for allowance.

§§ 102 – 103 Rejections:

Claims 38-39, 41, 43-44, 52, 57-59, 62, and 64-66 stand rejected under 35 U.S.C. § 102(b) as being anticipated by JP 11048399A (JP '399). Furthermore, claims 1-4, 6-14, 16-35, 38-40, 45-51, 53-56, 60-61, 63, and 67-69 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP '399. For the reasons described below, the Applicant respectfully traverses these rejections.

As the Examiner is well aware, independent claim 1 requires, among other claim elements, that the at least partially-transparent clearcoat composition be applied wet-on-wet to

the uncured film layer of the color-providing composition thereby forming an uncured film layer of the clearcoat composition on the uncured film layer of the color-providing composition, and independent claim 38 requires, among other claim elements, that the at least partially-transparent clearcoat film layer be formed from an at least partially-transparent clearcoat composition applied wet-on-wet to the color-providing composition as the color-providing composition is uncured.

In Paragraph [00004] of the original specification, the Applicant clearly explained that conventional coating systems, i.e., the coating systems of the prior art, were deficient in that such coating systems typically require cures, or bakes, between each film layer to achieve certain characteristics, such as suitable gloss and DOI. In making this explanation, the Applicant clearly distinguished the subject invention and identified that the prior art did not account for wet-on-wet application of the various film layers that make up the coating system. The Applicant further explained that the coating systems of the prior art were, therefore, time consuming and expensive. Ovens must be used for each cure step.

The Examiner is also well aware that the JP '399 prior art reference does not disclose, teach, or suggest the wet-on-wet application claimed in both independent claims 1 and 38. In contrast, the coating system of the JP '399 reference merely applies a liquid fluorescent paint onto a resin coat (or resin paint film) which is first formed by a powder coating...not a liquid coating.

Relative to the § 102 rejection of independent claim 38, on pages 2-3 of the Office Action, the Examiner concludes that she will give no weight to the positively recited claim limitations because the "limitations are process limitations that do not materially affect the final

cured product instantly claimed wherein the final product of JP '399 appears to be the same as the final product of the instant claims" (*emphasis added*). This reasoning by the Examiner is flawed. To conclude, as the Examiner has, that the wet-on-wet requirement associated with the coating system of claim 38 does "*not materially affect*" the final cured product is clearly an error. As explained by the Applicant and as those skilled in the art readily appreciate, coating systems prepared by a wet-on-wet application typically realize different appearance characteristics as compared to coating systems that implement a cure, or bake, between layers. Thus, a final cured product is materially affected by wet-on-wet preparation as opposed to wet-on-cured/baked preparation. In an effort to objectively capture the appearance issue identified above, the Applicant even claimed a certain DOI, Distinctness Of Image, value (see dependent claims 45, 51, 67, and 69).

In her rejection, the Examiner also concludes that "the final product of JP '399 appears to be the same as the final product of the instant claims." It is noteworthy that the Examiner chooses to use the word "appears" as there is not complete support for the § 102 rejection of all of the claims identified by the Examiner. There is no room for such guesswork in a § 102 rejection where an express or inherent disclosure of each and every claimed element is required. As just one example, the JP '399 reference is entirely silent with respect to certain DOI values and cannot be a sufficient § 102 reference against at least claims 45, 51, 67, and 69. To the contrary, the final product of JP '399 is not the same as the final product of the instant claims. As clearly explained in the JP '399 reference, its invention is "mainly used for inner sheathing of road related products, such as a guard fence for bridges, a road fence, and an indicator stanchion, and a building etc , and relates to the fluorescence paint metal body which can make

fluorescence maintain over a long period of time". There is no use for increased appearance levels in such industries as compared to the automotive coatings industry where wet-on-wet application of automotive body panels with increased appearance is frequently desired (see, for example, the particular substrate claimed in dependent claim 65). Simply stated, the JP '399 reference is entirely silent with respect to automotive body panels.

Relative to the § 103 rejection of independent claim 1, on page 3 of the Office Action, the Examiner concludes that "wet-on-wet application of a pigmented base coat followed by a clear topcoat with simultaneous curing would have been obvious to one having ordinary skill in the art at the time of the invention considering a wet-on-wet process is a functionally equivalent method to the method taught by JP '399" (emphasis added). There is no basis for this equivalence position by the Examiner. Thus, the Applicant traverses this § 103 (a) rejection.

The Applicant cannot emphasize enough that the wet-on-wet process claimed in the method of claim 1 is not functionally equivalent to anything disclosed or taught by the JP '399 reference. Instead, as the Examiner is aware and as described in Paragraph [0014] of the JP '399 reference, the JP '399 reference requires a heat melting of the powder coating so a resin paint film is formed first, i.e., prior to application of the liquid fluorescent paint. Those skilled in the art readily recognize that if one was to spray a liquid coating onto a powder coating before the powder coating was heat melted, i.e., while the powder coating was uncured, then the two layers would essentially meld into one layer and that the final appearance of the resultant coating system would be impacted.

In the context of this § 103 rejection, the Examiner is well aware of the criteria required to appropriately establish the *prima facie* case of obviousness. First, there must be some

suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Furthermore, the teaching or suggestion to make the claimed combination or modify a particular prior art reference must be found in the prior art, **and not based on applicant's disclosure**. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Precedential cases such as *In re Sang Su Lee* (277 F.2d 1338), *In re Zurko* (258 F.3d 1379), and *W.L. Gore v. Garlock, Inc.* (721 F.2d 1540) require that the Examiner refrain from overly conclusory statements when making an argument to modify a reference or motivation to combine references. *Gore* specifically recognizes that it is improper, in determining whether a person of ordinary skill would have been led to a modification of a particular reference, simply to "[use] that which the inventor taught against its teacher."

Simply stated, the Examiner is wrong in her conclusion that a wet-on-wet process is functionally equivalent to the method taught by JP '399. In fact, it can even be argued that by heat melting the powder coating prior to application of the liquid fluorescent paint, the JP '399 patent actually teaches away from the claimed invention. Furthermore, even if one were to assume for argument's sake that the Examiner is correct in this conclusion, the Examiner provides no support whatsoever for her conclusion that the two processes are equivalent. Thus, at least the first criterion required to appropriately establish the *prima facie* case of obviousness is not satisfied and this § 103 obviousness rejection is overcome.

In view of the remarks set forth above, it is apparent that the §§ 102 and 103 rejections of

independent claims 1 and 38 are overcome. Thus, it is respectfully submitted that these claims are allowable. The remaining claims depend either directly or indirectly from the novel and non-obvious features of claims 1 and 38 such that the dependent claims are also allowable.

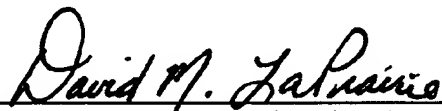
It is respectfully submitted that the Application is now presented in condition for allowance, which allowance is respectfully solicited.

No fees are believed to be due. However, if necessary, the Commissioner is authorized to charge Deposit Account No. 08-2789 for any additional fees or to credit the account for any overpayment.

Respectfully submitted,

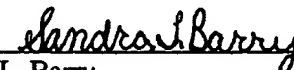
HOWARD & HOWARD ATTORNEYS, P.C.

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David M. LaPrairie, Registration No. 46,295
The Pinehurst Office Center, Suite 101
39400 Woodward Avenue
Bloomfield Hills, Michigan 48304-5151
(248) 723-0442

CERTIFICATE OF EXPRESS MAILING

I hereby certify that the attached Response, Terminal Disclaimer and fee are being deposited with the United States Postal Service as Express mail, Label No. EV764407710US postage prepaid, in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 27, 2005.


Sandra L. Barry